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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,066	01/17/2006	Markus Bergauer	PB60403	6157
20462 7590 12/18/2006 SMITHKLINE BEECHAM CORPORATION CORPORATE INTELLECTUAL PROPERTY-US, UW2220 P. O. BOX 1539 KING OF PRUSSIA, PA 19406-0939			EXAMINER BERNHARDT, EMILY B	
			ART UNIT.	PAPER NUMBER
			1624	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		12/18/2006	PAPER	

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/565,066

Applicant(s)

BERGAUER ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 15, 16, 19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 15, 16, 19 and 20 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_.

In accord with 35 USC 121 and 372, applicants are advised that where more than one process of making is claimed along with compounds, the first recited process is considered to form part of the main invention. See 37 CFR 1.475(d). Thus route (a) is only being examined along with optional steps appearing at the end of claim 11.

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between

product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claims 1-9,11,15,16,19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Scope of "aryl" requires clarification. In the specification on p.3 it is stated that both monocyclic and bicyclic aromatic rings are intended where one or more carbon atoms can be replaced by hetero atoms. However, the examples included as illustrative are not all aromatics. See pyrrolinyl,

pyrazolinyl, azepinyl, pyranyl. Also note benzosazinyl which is garbled. In claim 7-membered aromatics are recited. There are no neutral compounds having this ring size which are "aromatic" in the ordinary meaning of the term. Thus intended scope is not clear since "aromatic" has been distorted.

Note In re Hill 73 USPQ 482.

2. Nature of ring atoms in the NR<sub>3</sub>R<sub>4</sub> definition when R<sub>3</sub>/R<sub>4</sub> form rings with N is not set forth except for N. Note In re Wiggins 179 USPQ 421 regarding such terminology.

3. "Such as" appearing in claim 7 is improper alternative language since its not clear what is being claimed- subject before or after the phrase.

4. In route (a) of claim 11 it is not stated what reactant (III) is reacting with and what is the nature of the resultant final product. There is no conversion step being described and thus it is incomplete. In the same claim the optional step of converting one compound into another is not describing applicants' invention in the manner set forth under par. two as there are no reactant(s) recited nor products much less reaction conditions defining the interconversion(s) intended. This step should be deleted.

Claim 15 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating anxiety and depression,

does not reasonably provide enablement for all CNS disorders included in claim 15. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. The only activity reported in the specification is for 5 HT1-A binding and a description of serotonin reuptake inhibition. The notion that simply having these activities will enable treatment of a whole class of disorders such as eating disorders, cocaine and alcohol addiction, etc. is not substantiated by the current state of the art. It is known that treating anxiety and depression can be accomplished by 5 HT1-A antagonists and known serotonin reuptake inhibitors such as those mentioned on p.26 of the specification are useful for treating depression. See Robichaud and Jones provided with this action. Where the utility is unusual or difficult to treat or speculative, the examiner has authority to require evidence that tests relied on are reasonably predictive of *in vivo* efficacy by those skilled in the art. See for example, In re Ruskin 148 USPQ 221; Ex parte Jovanovics 211 USPQ 907. Note MPEP. 2164.05(a).

Claims 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The IDS of 1/17/06 cannot be considered unless copies of the reference(s) are provided. Only the search report is seen in the electronic file.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.



**EMILY BERNHARDT  
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